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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,269	04/24/2001	Kaoru Uchida	Q64131	3335

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SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

LIN, WEN TAI

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 08/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/840,269

Applicant(s)

UCHIDA, KAORU

Examiner

Wen-Tai Lin

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-60 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/19/05
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-60 are presented for examination.
2. In response to Applicant's explanation of the IDS filed on 1/19/2005, a signed copy of the PTO-1449 form is being mailed with this office action.
3. The text of those sections of Title 35, USC code not included in this action can be found in the prior Office Action.
4. It is noted that although the claim language uses "distributing a content" and "reproduction of the content" to describe/distinguish how a digital content is transferred or copied from one place to other, it is unclear what the differences resulting from the act of these two terms due to the lack of specific definition in the specification. Specifically, in a web-based content provisioning environment, when a content provider "distributes" a content to a requester's device, the content is in essence "reproduced" (or copied) from the original copy of the source content. For this reason, the terms "distributing a content" and "reproduction of the content" are construed as equivalent. Applicant is required to clarify by pointing to the specification for any differences he may perceive.

Claim Rejections - 35 USC § 103

5. Claims 1-8, 14-27, 33-42, 45-53 and 57-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Durrett [U.S. Pat. No. 5964830].

6. Durrett was cited in the previous office action.

7. As to claims 1 and 3, Durrett teaches the invention substantially as claimed including: a content distribution method for a user using a portal device (i.e., after logging onto a virtual disk server) to request a content object [col.1, line 66 – col. 2, line 7, wherein the content object can be a updated software object], wherein the user is authenticated [note that it is typical to authenticate a subscriber or registered member who request for accessing a content from a content provider] for requesting the content object and the content object is stored in the user's virtual disk [17, Fig.1, which is a user portal or "user terminal" to the world wide web] provided by an access provider (i.e., after being distributed by the content provider) [Fig.6B; col.7, lines 46-48]. In any subsequent session connecting with the virtual disk server, the user may request transfer (i.e., reproduction) of the previously requested content object (which is being stored in the user's virtual disk) to the portal device after a proper authentication with fingerprint features (i.e., the second authentication) [col.5, lines 3-6 and 45-51], wherein the biometric feature is encrypted [col.2, lines 40-42].

Durrett does not specifically teach the first authentication is performed with biometric features. However, since Durrett's portal device is equipped with fingerprint scanner for login authentication, it is obvious to also use the same device's biometric featuring capability for authenticating the content requester because it is well known that biometric feature provides higher security in the process of authentication.

8. As to claim 2, Durrett teaches that the digital contents include at least one of software, music, video, images and new items[col.1, line 66 – col.2, line 4].

9. As to claims 17 and 20, Durrett teaches the invention substantially as described in claims 1 and 8.

Durrett does not specifically teach personalizing a user terminal according to a terminal personalization setup data table.

However, Durrett teaches that each virtual disk user has its own disk space storing selected software elements, such as various operating systems for setting up a portal device according to a customer's choice [col.2, lines 24-32)].

Thus, in essence, it is obvious that each portal device can be personalized by loading an OS or application software at the time of initial connection with the virtual disk because the software typically requires a disk and would have to reside in the non-volatile memory of the virtual disk server.

10. As to claims 4-8, 14-16, 18-19, 21-27, 33-42, 45-53 and 57-60, since the features of these claims can also be found in claims 1-3, 17 and 20, they are rejected for the same reasons set forth in the rejection of claims 1-3, 17 and 20 and above.

11. Claims 9-13, 28-32, 43-44 and 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Durrett [U.S. Pat. No. 5964830], as applied to claims 1-8, 14-27, 33-42, 45-53 and 57-60 above, further in view of Official Notice.

12. As to claim 9, Durrett does not specifically describe restricting by a content distribution server, kinds of content to be distributed to said user terminal.

However, Official Notice is taken that it is well known in the art that a web server could impose restriction over what content is to be distributed to certain group of subscribers. It would have been obvious to one of ordinary skill in the art at the time the invention was made that the user of Durrett's portal device would receive similar restrictions such as the size of a content (to be distributed to its virtual disk server) because, for example, a portal device may not be able to display a large image.

13. As to claims 10-11, Durrett does not specifically teach transmitting to a content distribution server content utilization information including at least specific information regarding a person who has reproduced the content and information regarding said reproduced content; and charging the user who has reproduced the content or providing

a personal service for the user, according to said content utilization information sent to said content distribution server.

However, Official Notice is taken that, for purpose of targeted advertisement, collecting utilization information regarding an end-user's activities associated with a reproduced content is well known in the art. Further, charging a usage of content provided by content provider is also well known in that art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made that Durrett's content distribution server may also collect utilization information and charge as mentioned above because it serves better understanding of the users and help improving a follow-up advertisement.

14. As to claims 12-13, 28-32, 43-44 and 54-56, since the features of these claims can also be found in claims 1-2, 4-11, 14, 16, 23-27, 42 and 53, they are rejected for the same reasons set forth in the rejection of claims 1-2, 4-11, 14, 16, 23-27, 42 and 53 above.

15. Applicant's arguments with respect to claims 1-60 on 6/9/2005 have been considered but they are not deemed to be persuasive.

16. Applicant argues in the remarks that:

(i) In the immediate previous office action the examiner does not address the feature of "downloaded/distributed content can be redistributed to another user", which

was previously acknowledged that this feature was not disclosed or suggested by Durrett.

(ii) As to claim 1, Durrett does not teach or suggest a second authentication when reproducing the contents because Durrett's access provider only requires a user to be authenticated (via fingerprint) when the user logs into the access provider.

(iii) As to claims 10-11, Applicant requests an evidentiary document to support the Official Notice.

17. The examiner respectfully disagrees with applicant's remarks:

As to point (i): Applicant is reminded that the immediately previous office action was a non-final, where the examiner changed the grounds of rejection because of (1) a finding that the meaning of the phrases: "distributing a content" and "reproduction of a content" are indistinguishable [see paragraph #4 of the previous office action, to which Applicant failed to respond or clarify in the remarks filed on 6/15/05] and (2) new reasoning in lining up Durrett as a prior art.

As to point (ii): The previous office action maps the claim languages to the features of Durrett in two stages: Stage I occurs after a user logs into a virtual disk server, from which he obtains an initial OCO to make his portal device operational. The user is then free to access any web server for additional content and may store the content at the user's storage space with the virtual disk server [see e.g., col.1, line 66 – col.2, line 11]; that is, the first authentication occurs with the web server. Stage II occurs

when the user logs into the virtual disk server (at a later time) to transfer a previously accessed content from to the portal device, wherein the second authentication occurs (for which Durrett clearly teaches using fingerprint).

In the office action the examiner reasons that although Durrett does not teach the first authenticated via fingerprint, it is obvious to use the same since fingerprint is already available from Durrett's portal devices and it is more secure to use (with an underlying assumption that some of the web servers also support the fingerprint authentication method).

It is further noted that the aforementioned stage I maps to the so called "content distribution" feature of claim 1, while stage II maps to the "content reproduction" feature.

As to point (iii): In response to Applicant's challenge of the Official Notice, a US patent application publication [U.S. PGPub. 20020133412 A1] by Oliver et al. is provided as evidentiary support.

For at least the above reasons, it is submitted that the prior art of record reads on the claims.

18. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

19. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Examiner note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the contest of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday(8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:


(571)273-8300 for official communications; and

(571)273-3969 for status inquires draft communication.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

August 15, 2005


8/15/05